

## **REMARKS**

Claims 1, 3, 9, 10, 17, 18, 24 and 25 have been amended to place the above-referenced application in better condition for allowance. In view of these amendments and the following reasoning for allowance, the applicants hereby respectfully request further examination and reconsideration of the subject application.

### **The Objection to the Drawings**

In the above-identified Office Action, the Examiner objected to the drawings because of several reference sign anomalies. Proposed drawing corrections or corrected drawings were required. In response, the applicants have included herewith proposed corrections shown in red that are believed to resolve the anomalies. It is respectfully requested that the proposed drawing corrections be approved. Also note that in order to correct the repeated reference number 524, the specification was also amended to use reference number 525 in the second incidence, instead of 524.

### **The Section 112, Second Paragraph, Rejections of Claims 9 and 10**

Claims 9 and 10 were rejected under 35 USC 112, second paragraph, as being indefinite. It is believed that the foregoing amendments to the claims have clarified any indefiniteness that existed in the original claim language.

Specifically, Claim 9 was rejected as being indefinite because the timing of the "act of determining" and the user interaction is contradictory and unclear. In response, the applicants have eliminated the portion of the claim involving the user interaction.

As to Claim 10, the term "processor background cycles" was found indefinite, and the Examiner suggested it be replaced with the term "background process". This suggestion has been adopted.

It is believed the amended claims now fulfill the requirements of 35 USC 112, second paragraph, as they particularly point out and distinctly claim the subject matter that the applicants regard as the invention. Therefore, it is respectfully requested that the rejection of Claims 9 and 10 be reconsidered.

In addition, it is noted that Claims 1, 24 and 25 were amended to remove a non-essential element from the independent claims (i.e., the feature whereby the email address is checked against addresses in one or more contact databases). Further, in the case of the process claim set beginning with Claim 1, this element was placed in dependent Claim 3. Claims 17, 18 were amended to conform them to the foregoing changes made in their base and intermediate claims. Specifically, they were made dependent from Claim 3, rather than Claim 1.

#### The Section 103(a) Rejection of Claims 1-25

Claims 1-25 were rejected under 35 USC 103(a) as being unpatentable over Spencer, et al., U.S. Patent No. 6,349,299 (hereinafter Spencer) in view of Holtz et al., U.S. Patent No. 6,433,800 (hereinafter Holtz). It is contended in the Office Action that Spencer teaches all the elements of the rejected claims with the exception of marking the email address with an adjacently placed indicator. However, it is further contended that the Holtz reference teaches this feature. Thus, it was concluded that it would have been obvious to incorporate the Holtz teachings into Spencer to produce the applicants' claimed invention. The applicants respectfully disagree with this contention of obviousness as it is believed that the Holtz reference does not teach or suggest marking an email address with an indicator.

More particularly, the applicants claim a system and process that allows a user to treat email addresses found in incoming and outgoing emails as objects. As such the user can, for example, add them to a contact list, copy them to the computer's clipboard, or "double-clicked" to open the related contact information for that email address' sender, among other things. To facilitate this manipulation of the email addresses, a small indicator icon is added to the text of each address. In some embodiments, the icons will vary depending on the pedigree of the address. For outgoing messages, the pedigree of the address or list is determined by monitoring where the user obtained the address. For incoming messages, the message is parsed and searched to find addresses that match the receiving user's address book. If no match is found, a generic address icon is added before the text of the address, while the system checks the email header against other address sources such as server lists. Once the address is marked with an appropriate icon the user can manipulate the address in various ways allowing the user to readily edit or add email addresses to their contact list.

The cited combination on the other hand lacks any teaching or suggestion that the aforementioned icon be added to the text of the email address as a prerequisite to its manipulation as an object. It was stated in the Office Action that Spenser lacked such a teaching. Thus, in order to find the claimed invention obvious, this teaching must be found in the Holtz reference. However, no such teaching exists.

The Examiner contends that the claimed feature of appending an icon to the email address is taught in the abstract of the Holtz reference, as well at Col. 3, lines 8-10 and 13-15. The Abstract of Holtz reads:

"Apparatus, and an associated method, provides **iconic representations of actions** available to be performed upon an object of a particular datatype. The iconic representations are

displayed, for instance, as part of a toolbar on a computer display. A representation of an object upon which an action is to be performed is dragged-and-dropped upon the iconic representation of the selected action to invoke that action upon both the dropped object and the object of a particular datatype.” (*emphasis added*)

Additionally, the cited sections of Holtz read:

• **“Icons representing the addressing of the e-mail message and an attachment action are displayed** upon the computer display device... Operation of other embodiments of the present invention analogously simplify other operations, such as address card operations and network operations”. (*emphasis added*)

However, Holtz is not teaching the appending of an indicator icon to an email address. Rather, it teaches the representation of an action (such as the task of addressing an email or attaching a file to an email) as an icon. This is evidence by the bolded phrases in the foregoing Holtz citations.

Granted, Holtz does mention that the objects that are acted upon are also represented by an icon, which is then selected and dragged to the icon representing the desired action. Thus, in the email example given in the cited portion of Holtz, the email message itself would be represented by an object icon and could be dragged to the icon representing the addressing function. The email would then be acted upon in a conventional way to address it, presumably using an email address book program of some type. Similarly, an attachment file to an email would be represented by an icon, and this object icon could be dragged and dropped onto the action icon representing the task of attaching the file to the email. However, this scenario is clearly different from the claimed invention and is in no way suggestive of it.

Nowhere in Holtz is it suggested that an email address be represented by an object icon. In fact, this would make no sense. An object icon is used to represent an object, such as a document, that would be too large and cumbersome to display otherwise in the context of the Holtz invention. Conversely, an email address is typically quite short and there would be no need or incentive to represent it using some kind of generic email datatype icon. Holtz does state:

“Operation of an embodiment of the present invention facilitates user initiation of performance of actions upon one or more objects resident at the computer system. The objects resident at the computer system are data-typed according to the object's type. For instance, the object might be a Microsoft Word object or an Excel object, or an analogously-typed object...In some conventional icon-based operating systems, such as CDE (common desktop environment) or Windows-95, the objects are typically represented by object icons upon the computer display device 26.” (Col. 4, lines 48-60)

However, the applicants are not aware of any icon-based operating systems where an email address is represented by an icon.

Further, there is no suggestion in Holtz that an object icon be appended to an email address. Holtz teaches that Microsoft Word, Excel, or analogously-typed objects are sometimes represented by object icons. This is not the same as appending an indicator to the text of an email address. This would be akin to appending a generic object-type icon to a display of one of the aforementioned object datatypes of Holtz. Again, this would be impractical and of no value to the described invention. Thus, it cannot be deemed that the reference teaches appending object icons to anything, much less an email address.

In order to deem the applicant's claimed invention unpatentable under 35 USC 103, a prima facie showing of obviousness must be made. To make a prima

facie showing of obviousness, all of the claimed elements of an applicant's invention must be considered, especially when they are missing from the prior art. If a claimed element is not taught in the prior art and has advantages not appreciated by the prior art, then no prima facie case of obviousness exists. The Federal Circuit court has stated that it was error not to distinguish claims over a combination of prior art references where a material limitation in the claimed system and its purpose was not taught therein (*In Re Fine*, 837 F.2d 107, 5 USPQ2d 1596 (Fed. Cir. 1988)).

In this case, neither Spencer nor Holtz teach the applicant's claimed feature of marking an email address with an adjacently placed indicator, which upon selection by a user allows the manipulation of the address as an object. This marking has distinct advantages including alerting the user to the location of an email address and its availability for manipulation. Thus, the applicants have claimed a feature not taught in the cited combination, and which has advantages not recognized therein. Accordingly, no prima facie case of obviousness can be established in accordance with the holding of *In Re Fine*. This lack of prima facie showing of obviousness means that the rejected claims are patentable under 35 USC 103 over Spencer in view of Holtz. As such, it is respectfully requested that the rejection of Claims 1-25 be reconsidered based on the non-obvious claim language,

“marking the email address with an adjacently placed indicator; and upon selection of the indicator by the user, allowing the user to manipulate the email address as an object”.

#### The Section 103(a) Rejection of Claims 1-3, 12, 15, 18, 20, 24 and 25

Claims 1-3, 12, 15, 18, 20, 24 and 25 were rejected under 35 USC 103(a) as being unpatentable over Teri Battles, “Tips For Using Yahoo Email” (hereinafter Yahoo), in view of Nielsen, U.S. Patent No. 6,405,243. It is contended in the Office

Action that the Yahoo reference teaches all the elements of the rejected claims with the exception of the features pertaining to (1) identifying an entry in the preview pane or full message window of an email message as an email address, and (2) checking the email address against addresses in one or more contact databases. However, it is further contended that the Nielson reference teaches these features. Thus, it was concluded that it would have been obvious to incorporate the Nielson teachings into Yahoo to produce the applicants' claimed invention. The applicants respectfully disagree with the contention of obviousness.

Specifically, it is the applicants' position that there is no motivation to modify the Yahoo teachings with that of Nielson. In regard to the Yahoo reference, it teaches that an "Add to Address Book" link be displayed at the end of the "From" line in a received email. (see Page 2, lines 1-4). The sole purpose of this link is to, when selected by a user, add any email address appearing in the "From" line to an Address book. Nielson teaches an email address updating service. As part of this service a user sends an update message to an address-change server. This message contains in the body thereof prescribed fields, some of which are mandated to include email addresses. In particular, one field contains the user's old email address, another contains any variation of the old address, and a third field contains the user's new email address. (see Col. 3, lines 52-59). Thus, in this aspect of the invention, the server accesses email addresses from a set of prescribed fields in the body of an incoming message. In another aspect of the Nielson invention, when a person wishing to send an email to someone whose email address has changed and is unknown to the sender, the sender sends an email message to the address-change server that includes in the body thereof the desired recipient's old email address. The address must be prefaced with a keyword indicating to the server that it is an old email address to which the sender wants to find an update. (see Col. 4, lines 59-63). Thus, in this case the server accesses an email address from the body of an email if it is prefaced by a prescribed keyword. These foregoing aspects of the Nielson reference are the only ones that have anything to do with finding email addresses in an email message.

Given the above, the proposed combination of Yahoo and Nielson would presumably result in an "Add to Address Book" link being appended to any email address found in a prescribed field of an incoming email or found following a prescribed keyword. However, such a modification would be ludicrous. The purpose of the Yahoo scheme is to facilitate the population of an email address database with the email addresses of people sending emails to a user. There is no reasonable expectation that such emails will contain prescribed fields or keywords in the body thereof. Accordingly, a person of ordinary skill in the art would have no reason whatsoever to implement the Nielson teachings into the Yahoo scheme. Granted in the above-identified Office Action it was stated that a motivation to combine the cited references existed in that an ordinary artisan would look for a way to reduce the operating time on maintaining email addresses in Yahoo Mail. However, since there is no reasonable expectation that there will be prescribed fields containing email addresses, or keyword-prefaced email addresses, in the bodies of incoming emails handled by Yahoo Mail, the incorporation of the Nielson teachings would be worthless. Accordingly, the reduction in operating time contended to be the motivation factor to combine the references is illusory.

In order to deem the applicants' claimed invention unpatentable under 35 USC 103, a prima facie showing of obviousness must be made. In *ACS Hospital Systems, Inc. v. Montefiore Hospital*, [732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)] it was stated,

"Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion, or incentive supporting the combination.

As shown in the foregoing arguments, the cited references do not provide such a teaching, suggestion or incentive. Thus, no prima facie case of obviousness can be established. This lack of prima facie showing of obviousness means that the



rejected claims are patentable under 35 USC 103 over Yahoo in view of Nielson. As such, it is respectfully requested that the rejection of Claims 1-3, 12, 15, 18, 20, 24 and 25 be reconsidered based on the non-obvious claim language,

“identifying an entry in the preview pane or full message window of an email message as an email address; marking the email address with an adjacently placed indicator; and upon selection of the indicator by the user, allowing the user to manipulate the email address as an object”.

#### Summary

In summary, it is believed that the claims are in condition for allowance. Accordingly, reconsideration of the rejection of Claims 1-25 is respectfully requested. In addition, allowance of these claims at an early date is courteously solicited.

Respectfully submitted,



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